

22 AUG 2000



UNITED STATES DEPARTMENT OF COMMERCE
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Patent Cooperation Treaty
Legal Office

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In re Application of
WIDERSTROM
Application No.: 09/051,443
Filing Date: 10 April 1998
Attorney's Docket No.: 06275/124001
For: DISPOSABLE INHALER

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: DECISION
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This application is before the PCT Legal Office for consideration of matters arising under 35 U.S.C. 371.

BACKGROUND

On 29 January 1998, applicants filed international application PCT/SE98/00131, which claimed priority of an earlier Swedish application filed 07 February 1997. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 13 August 1998. A Demand for international preliminary examination, in which the United States was elected, was filed on 21 August 1998. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 07 August 1999.

On 10 April 1998, applicants filed a transmittal letter for entry into the national stage in the United States, which was accompanied by, *inter alia*, the basic national fee; a specification, claims, and abstract, a preliminary amendment, and a declaration. The preliminary amendment, filed on the same date, amends the first line of the specification as a "continuation of International Patent Application No. PCT/SE98/00131".

On 21 October 1999, the United States Designated/Elected Office mailed a NOTIFICATION OF ACCEPTANCE OF APPLICATION UNDER 35 U.S.C. 371 AND 37 CFR 1.494 OR 1.495 (Form PCT/DO/EO/903).

DISCUSSION

Any intended filing of an international application as a national stage application must clearly and unambiguously be identified as such and must satisfy all of the conditions set forth in 35 U.S.C. 371(c). The official PTO Notice published in the Official Gazette at 1077 OG 13 entitled "Minimum Requirements for Acceptance of Applications Under 35 U.S.C. 371 (the National Stage of PCT)" states, in part, the following:

The Patent and Trademark Office is continuing to receive application papers which do not clearly identify whether the papers (1) are being submitted to enter the national stage of the Patent Cooperation Treaty (PCT) under 35 U.S.C. 371 or (2) are being filed as a regular national application under 35 U.S.C. 111.

* * *

If there are any conflicting instructions as to which sections of the statute (371 or 111) is intended the application will be accepted under 35 U.S.C. 111.

The transmittal letter (Form PTO-1390) filed on 10 April 1998 identified the application as "a filing under 35 U.S.C. 371." However, the preliminary amendment amended the first line of the specification to read as "This is a continuation of International Patent Application No. PCT/SE98/00131". Applicants' reference to the papers as a continuation application in the first sentence of the specification is inconsistent with the transmittal letter filed 10 April 1998 and contradicts the request in the transmittal letter to file under 35 U.S.C. 371. The transmittal letter (Form-1390) used by applicant is to be used only with submissions under 35 U.S.C. 371. Since applicants gave conflicting instructions, the papers should have been considered as having been filed under 35 U.S.C. 111(a). Accordingly, the original papers deposited on 10 April 1998 were improperly accepted as a submission under 35 U.S.C. 371. Therefore, the NOTIFICATION OF ACCEPTANCE mailed 21 October 1999 is hereby VACATED. The application is deemed to have been filed under 35 U.S.C. 111(a).

It is noted that the specification which will be examined in the instant application is the copy submitted by applicants on 10 April 1998. Although the Annexes accompanying the International Preliminary Examination Report (IPER) have been entered (according to proper procedure for processing an application under 35 U.S.C. 371), these Annexes will be removed and replaced with the pages from the copy of the specification submitted by applicants on 10 April 1998. The application, which is now treated as having been filed under 35 U.S.C. 111, has not yet been examined on the merits. Moreover, it appears to be the intent of applicants to not have the Annexes considered. The preliminary amendments filed 10 April 1998 and 19 August 1999 both correspond to the copy of the specification as filed rather than to the copy of the international application as amended during the International Preliminary Examination. Additionally, the IPER was not established until 17 May 1999, which is after the submission on 10 April 1998 of the application papers.

The declaration filed 10 April 1998 is acceptable. While the declaration executes the specification "which was described and claimed in PCT International Application No. PCT/SE98/00131", the specification submitted on 10 April 1998 appears to be a copy of, and thus identical to, the international application as published. Accordingly, the declaration filed 10 April 1998 executes the copy of the specification filed 10 April 1998. If the specification submitted on 10 April 1998 and the international application are not identical, applicant must *immediately* notify the United States Patent and Trademark Office of such fact.

CONTINUATION APPLICATION

Applicants are entitled to claim benefit under 35 U.S.C. 120 and 365(c) of the filing date of the international application for the common subject matter, since this application (Serial No. 09/051,443) and the international application (PCT/SE98/00131) designating the United States were copending on 10 April 1998.

Applicants are reminded that in order to perfect the claim for priority under 35 U.S.C. 119, applicants must submit certified copies of the priority documents. The certified copies of priority documents submitted to the International Bureau cannot be relied upon to perfect the claim for priority. See MPEP § 1896.

CONCLUSION

This application is accepted as an application filed under 35 U.S.C. 111(a) with a filing date of 10 April 1998.

This application is being forwarded to the National Stage Processing Branch of the Office of PCT Operations for processing in accordance with this decision, that is for (1) removal of the papers communicated from the International Bureau to the United States Patent and Trademark Office concerning international application PCT/SE98/00131 including removal of the Annexes (pages stamped "AMENDED SHEETS") and replacement of these pages with the pages from the copy of the specification submitted by applicants on 10 April 1998, (2) correction of information in PALM (computer database), and (3) correction of fees. Afterwards, the application will be forwarded to the Office of Initial Patent Examination for processing as a national application filed under 35 U.S.C. 111(a) with a filing date of **10 April 1998** including scanning of the application and issuance of a corrected filing receipt. The application will then be forwarded to the

appropriate Technology Center for examination. Before examination, the Technology Center will enter the preliminary amendments filed 10 April 1998 and 19 August 1999.



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